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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/600,984

06/20/2003

Kurt R. Carlson

NGC-140/000047-199

7137

32205 7590 11/30/2010

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EXAMINER

ZEMEL, IRINA SOPHIA

ART UNIT

PAPER NUMBER

1765

MAIL DATE

DELIVERY MODE

11/30/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/600,984	<b>Applicant(s)</b> CARLSON ET AL.	
	<b>Examiner</b> Irina S. Zemel	<b>Art Unit</b> 1765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6, 14, 15 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 14, 15 and 21-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6,14-15,21-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The newly added limitation is indefinite for the following reasons; it is absolutely not clear what the claimed limitations relates to and also how it relates to the steps of the claimed process. None of the steps claims anything even remotely related to a step/thing/material that can be associated with the newly claimed limitation of " whereby a Shupe bias of a qyro including the polymeric material g is reduced."

In addition, this limitation appears to claim a property of some device where this polymeric material is included. Since no such step is claimed, it appears that the limitation relates to a future use of "the polymeric material", i.e., a property that may be obtained in the future should the polymeric material be used in some way. Such limitation is clearly indefinite, since it is not a property of any claimed product or the product resulting from the claimed process.

Moreover, "the polymeric material" refers to the initial polymeric material to which the voids are introduced, not a material already that comprises voids.

In addition, the claimed method is not defined by any method objective, (i.e., what is the intended purpose of the method such as "a method of making a

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product (such as foam, polymer, tool etc.),” or a “method of using a product in a specific way”, or “a method of cleaning a chamber”, etc., etc.), and is only defined by the steps. Thus, it is not clear, based on the claimed steps only, what “gyro” is characterized by the claimed property and how the claimed gyro relates to any of the claimed steps.

*It is expressly noted on the record that the claims directed to specific steps of encapsulating a fiber optic of gyroscope with a potting compound were NON-ELECTED for examination in the instant application and were cancelled by the applicants.*

### ***Claim Rejections - 35 USC § 102/103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3 and 14-15,24, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by EO 752603 to W.L. Gore and Associates (hereinafter “W.L. Gore”) as evident from “Poisson’s Ratio of Foamed Plastics” by Dement’ev et al., (hereinafter “Dement’ev”).

The rejection stands as per reasons of record. ‘Insofar as the newly added limitation of " whereby a Shupe bias of a gyro including the polymeric material g is reduced,” this limitation, as discussed above, is not related to any of the claimed steps and appears to be property limitation of some product resulting in specific future use of “the polymeric material” ( or maybe the sensor fibers

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encapsulated in the void containing polymer material resulting from the claimed method). As such, this limitation is not given any patentable weight. Not to mention, that since , as discussed in the previous office actions, the material obtained via the process of the prior art is substantially similar to the material obtained via the claimed process, the claimed limitation, again, is inherently met by the material disclosed by the prior art as being substantially identical materials, should the materials of the prior art be used in "gyro" or any other end use.

***Claim Rejections - 35 USC § 103***

Claims 1-4, 15 and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 660082 to Andrew A.G as evident form "Poisson's Ratio of Foamed Plastics" by Dement'ev et al., (hereinafter "Dement'ev").

The rejection stands as per reasons of record and discussion of the newly added limitation above.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Andrew A.G. in combination with US 5,706,175 to Takei (as evident form "Poisson's Ratio of Foamed Plastics" by Dement'ev et al., (hereinafter "Dement'ev").

The rejection stands The rejection stands as per reasons of record and discussion of the newly added limitation above.

Claims 1-3 and 15, 24, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO99/36820 to SUN Microsystems Inc., (hereinafter "SUN") in combination with US Patent 4,107,354 to Wilkenloh et al., (hereinafter Wilkenloh) or W.L. Gore (as evident form "Poisson's Ratio of Foamed Plastics" by Dement'ev et al., (hereinafter "Dement'ev"))).

The rejection stands as per reasons of record and discussion of the newly added limitation above..

### ***Response to Arguments***

Applicant's arguments filed 9-30-2010 have been fully considered but they are not persuasive.

First of all, the applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Second, the applicants statement that the" art previously cited and relied on by the examiner is unrelated to the physical properties achieved in the material described herein above. The art cited is concerned with bendability, rather than bulk and Young's modulus properties" (which is not an argument on how the instant invention , but rather a statement related to the disclosure of the prior art), is noted but is considered to be irrelevant to the patentability of the claimed method. As discussed in great detail in the previous office action, the claimed properties are reasonable believed to be inherent properties of the

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product disclosed in the prior art. Whether or not the prior art disclosed such properties is immaterial to the patentability of the material. Not only the properties are inherited, but as has been long established by the courts "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

In addition, there is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure *at the time of invention*, but only that the subject matter is in fact inherent in the prior art reference. *Schering Corp. v. Geneva Pharm. Inc.*, 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003) 182 F.3d 1315, 1319, 51 USPQ2d 1307, 1310 (Fed.Cir.1999).

Therefore, the rejection of all pending claims stands.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The

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fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Irina S. Zemel/  
Primary Examiner, Art Unit 1765

Irina S. Zemel  
Primary Examiner  
Art Unit 1765

ISZ